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In re Application of :
PYZIK, et al. :
U.S. Application No.: 10/551,727 : DECISION ON PETITION
PCT No.: PCT/US04/10837 :
Int. Filing Date: 08 April 2004 : UNDER 37 CFR 1.137(a)
Priority Date: 09 April 2003 :
Attorney Docket No.: 62620A :
For: COMPOSITION FOR MAKING METAL :
MATRIX COMPOSITES :
:

This decision is in response to applicant's petition for revival of an application for patent abandoned unavoidably under 37 CFR 1.137(a) filed 30 October 2008 in the United States Patent and Trademark Office (USPTO). As authorized the \$540.00 petition fee will be charged to deposit account number 04-1512.

BACKGROUND

On 08 April 2004, applicant filed international application PCT/US04/10837 which claimed priority to a previous application filed 09 April 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 09 October 2005.

On 03 October 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 22 January 2008, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 15 September 2008, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) informing application that the present application was abandoned as to the National stage in the United States for failure to respond to the Form PCT/DO/EO/905 mailed on 22 January 2008.

On 30 October 2008, applicant filed the present petition under 37 CFR 1.137(a).

DISCUSSION

A petition to revive an application must contain: 1) the petition fee; 2) the proper reply; 3) a statement of unavoidable delay and 4) a terminal disclaimer if required. Applicant has satisfied item 1 and item 4 does not apply.

As to item 2, Regarding item (4), the filed declaration does not comply with 37 CFR 1.497 (a)-(b). Specifically, MPEP Section 201.03 states that:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The filed declaration contains four front pages of the declaration and three second pages, each individually executed by the seven inventors. This suggests that either the filed declaration was compiled from numerous declarations or that the inventors only returned their signature pages. Either scenario renders the document non-compliant.

Regarding item 3, applicant's statement does not rise to the exacting standard of unavoidable delay. MPEP section 711.03(c) states that "unavoidable" delay is the epitome of 'unintentional' delay. Thus, an unintentional delay precludes revival under 37 CFR 1.137(a).

In addition, section 711.03(c) states:

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Applicant's present petition does not provide sufficient detail as to the unexpected failure of the firm's docketing procedures to conclude that the failure to respond to the Form

PCT/DO/EO/905 was unavoidable.

It appears from the description of events provided in the petition that the matter would be more properly resolved pursuant to 37 CFR 1.181 and a petition to withdraw the holding of abandonment.

Official Gazette notice 1156 OG 53 and the Manual of Patent Examining Procedure 711.03(c), explain what is required for a petition under 37 CFR 1.181 requesting relief based upon non-receipt of an office action:

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner **>describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.137(a) is **DISMISSED**.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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